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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,807	01/22/2001	Yasuyuki Murakami	81942.0011	8416
26021	7590	07/07/2004	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			MOORTHY, ARAVIND K	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,807

Applicant(s)

MURAKAMI, YASUYUKI

Examiner

Aravind K Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/22/01, 2/9/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-11 are pending in the application.
2. Claims 1-11 have been rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3, 5, 7, 8, 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Sako et al U.S. Patent No. 6,169,803 B1.

As to claims 1, 3, 8, 10 and 11, Sako et al discloses a common key generating method for generating a common key used in performing an encryption process of encrypting a plaintext into a ciphertext and a decryption process of decrypting the ciphertext into the plaintext mutually between a plurality of entities, comprising the steps of:

obtaining a secret key of one of the entities generated using identification information of the one entity; and

generating a common key based on the obtained secret key and identification information of the other entity as a communicating party,

wherein, if the identification information of the other entity lacks a component, the common key is generated after adding a part of components of the identification information of the one entity to the identification information of the other entity [column 6 line 50 to column 7 line 25].

As to claim 5, Sako et al discloses a cryptographic communication method for transmitting information in ciphertext form between first and second entities, comprising the steps of:

sending secret keys generated using identification information of the first and second entities from a key issuing agency to the respective entities;

at the first entity, if the identification information of the second entity lacks a component, adding a part of components of the identification information of the first entity to the identification information of the second entity, and generating a first common key based on the secret key of the first entity sent from the key issuing agency and the identification information of the second entity to which the part of components has been added [column 6 line 50 to column 7 line 25];

at the first entity, encrypting a plaintext into a ciphertext by using the generated first common key, and transmitting the ciphertext to the second entity [column 10 line 64 to column 11 line 43];

at the second entity, if the identification information of the first entity lacks a component, adding a part of components of the identification information of the second entity to the identification information of the first entity, and generating a second common key identical with the first common key, based on the secret key of the second entity sent from the key issuing agency and the identification information of the first entity to which the part of components has been added [column 6 line 50 to column 7 line 25]; and

at the second entity, decrypting the transmitted ciphertext into a plaintext by using the generated second common key [column 11, lines 44-58].

As to claim 7, Sako et al suggests a plurality of key issuing agencies are present, and each of the key issuing agencies generates secret keys of the first and second entities by using divided identification information obtained by dividing the respective identification information of the first and second entities [column 6 line 50 to column 7 line 25].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sako et al U.S. Patent No. 6,169,803 B1 as applied to claims 1, 3 and 8 above, and further in view of Lee et al U.S. Patent No. 5,958,007.

As to claims 2, 4, 6 and 9, Sako et al does not teach that the identification information is an electronic mail address, and the part of components is a domain name.

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Lee et al teaches the domain part of an electronic email address for identification information.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sako et al so that the identification information would have been the domain name part of an electronic mail address.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sako et al by the teaching of Lee et al because it allows a user at a remote location to obtain the key securely [column 2, lines 28-36].


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
June 30, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100